

Serial No. 09/715,439
Attorney Ref. No. 1205-002/JRD

REMARKS

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This amendment responds to the Office Action dated September 20, 2005. Claims 1-6, 9, 10, 13, 15-17, 19-23, 26-28, 30, and 44-51 are in the application. Claims 1, 9 and 44 are in independent form. Claims 7, 8, 11, 12, 14, 18, 24, 25, 29, 31-43, and 52-61 have been cancelled.

Reconsideration is respectfully requested in light of the following remarks.

35 USC § 103

The claims stand rejected under 35 USC § 103 for obviousness over U.S. Pat. No. 6,464,142 to Denenberg ("Denenberg") in view of U.S. Pat. No. 6,496,806 to Horwitz ("Horowitz") and others. Applicants respond as follows.

Denenberg is directed to a will call system that uses optical scanners to scan bar codes that are placed on prescriptions in a pharmacy. As illustrated in Fig. 3 of Denenberg (reproduced below), a single bar code scanner 50 is used for a cabinet 15 of storage locations 13.

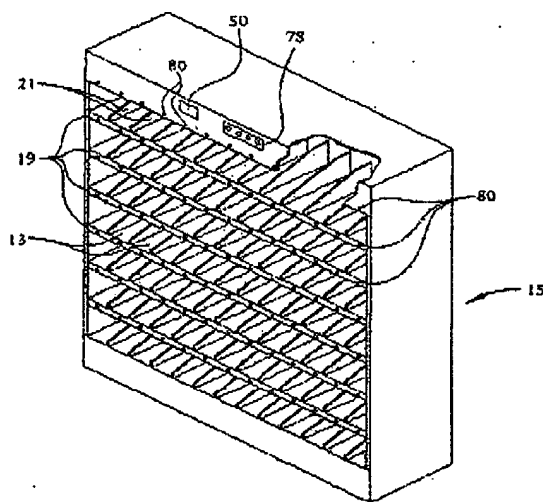


FIG. 3

In operation, a worker scans the bar-coded prescription in front of the bar code scanner 50 and places the prescription in the location 13 indicated by the system. As illustrated in Figs. 5A and 5B (reproduced below), the storage location 13 may include an article

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sensor 23 that can detect that an article is placed in the storage location by disruption of a light beam from a light source 24.

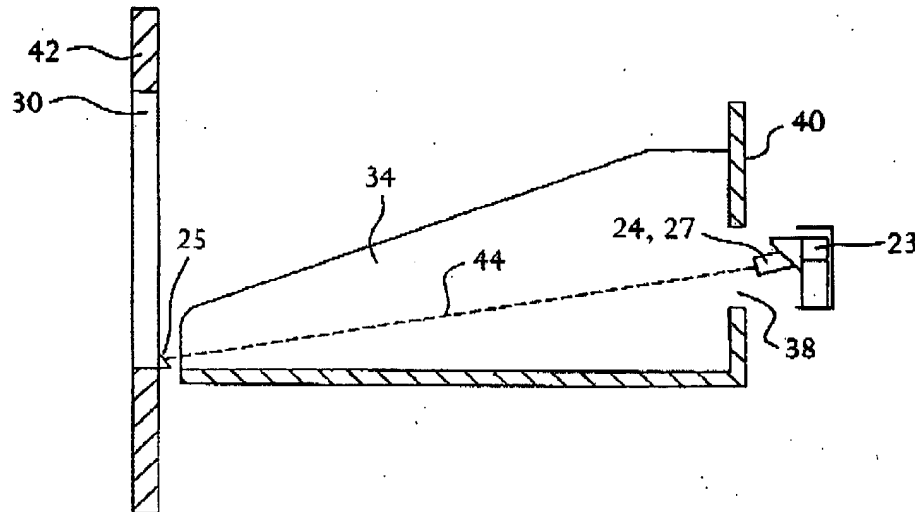


FIG. 5A

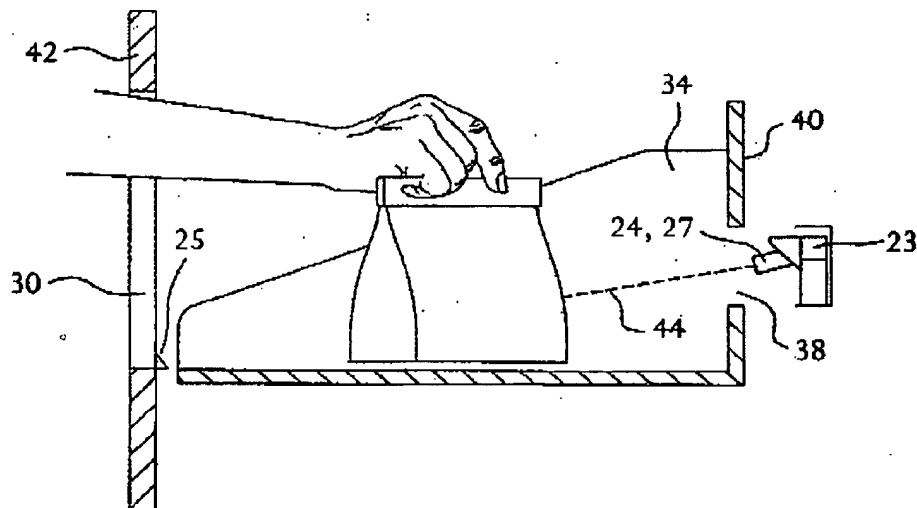


FIG. 5B

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Independent claims 1, 9, and 44 have been amended to clarify that a filled prescription order is placed into a compartment out of an array of compartments in a storage area and that each compartment has a corresponding compartment tag reader that is in communication with the computer system. Claim 1 clarifies that the tag reader is operable to read the unique identifier of the tag on the filled prescription order regardless of the orientation of the tag.

Denenberg does not teach or suggest such prescription order tracking, whether alone or in combination with any of the cited references. Denenberg describes a single bar code scanner in front of which a worker must hold a bar-coded prescription before placing the prescription in a storage location. While in the storage unit of Denenberg, a bar-coded prescription is no longer identifiable by the system. The article sensor of Denenberg detects that something is in a storage location, but does not specifically read the bar code on the prescription in the storage location. For example, a hurried worker holding many prescriptions could inadvertently scan one prescription and place another in the indicated storage location. As a result, Denenberg fails to provide a complete "chain of custody" of the filled prescription in storage and thereby fails to provide a fail-safe identification of which prescription is located in each location.

In contrast, independent claims 1, 9, and 44 specifically recite that each storage compartment that has, in the language of claim 1, "compartment tag reader that is in communication with the computer system and is operable to read the unique identifier of the tag on the filled prescription order regardless of the orientation of the tag. The ability to read the tag of the filled prescription while it is in its storage compartment means that the present invention specifically identifies each and every prescription that is actually in each storage compartment. Denenberg and the other references fail to provide the same degree of certainty and, therefore, increase the probability of a worker distributing an incorrect prescription.

Accordingly, applicants submit that claims 1, 9, and 44 are patentably distinct from the cited references and request that the claims be allowed. Applicants submit that the claims depending from claims 1 and 9 are allowable as dependents of allowable base claims. In addition, applicants submit that selected ones of the base claims are allowable for the following additional reasons.

Dependent claims 10 and 26 recite that compartment tag readers associated with corresponding apartments each include an antenna and the antennas of plural tag

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readers are activated and read by a tag activating circuit in a multiplexed manner. As described in the application, such multiplexing allows a storage unit with large numbers of compartments to affordably include a tag reader in each compartment.

Denenberg would lead one of ordinary skill in the art away from such an implementation by teaching use of a single bar code scanner at a storage unit. None of the other cited references teaches or suggests such multiplexing of tag readers to provide a large number of reader locations (i.e., compartments) from a single tag activating circuit. Applicants submit, therefore, that claim 10 is further patentably distinct and request that it be allowed.

**"OBVIOUSNESS" NOT ADEQUATE GROUNDS TO
REJECT SECONDARY CONSIDERATIONS**

Applicants respectfully traverse the examiner's refusal to consider the previously submitted evidence of commercial success, long felt need, and copying on the grounds that "the prior references disclosed all the limitations as required by the claims and sufficient motivation is provided by the Examiner."

As Applicants best understand this ground for rejection, the Examiner has refused to consider the submitted evidence because he has found the invention "obvious." However, secondary considerations, such as proof of commercial success, long felt need, and evidence of copying, overcome a prima facie rejection under 35 USC Sec. 103. (See MPEP 716.01 (B) and 2141).

"Where the evidence is insufficient to overcome the rejection, the examiner must specifically explain why the evidence is insufficient. General statements such as 'the declaration lacks technical validity' or 'the evidence is not commensurate with the scope of the claims' without an explanation supporting such findings are insufficient." (MPEP Sec. 716.01 (B)) Accordingly, Applicants respectfully request clarification as to why the prima facie rejection under USC Sec. 103 has not been overcome by the secondary considerations of record.

Applicants maintain that the previously submitted evidence satisfies the necessary proof requirements of MPEP 716, and it overwhelmingly establishes the non-obviousness of the invention as currently claimed. To facilitate examiner review, a summary of this evidence is re-presented below:

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1. Evidence of Long-Felt Need That Was Recognized, Persistent, and Not Solved by Others.

The best example of the need for better prescription order tracking and will-call retrieval can be found by conducting a brief search of recent judgments against pharmacies for distributing the wrong prescription to customers. For example, a jury recently awarded a customer of Wal-Mart Stores, Inc. over \$800,000 in damages for accidentally giving that customer the filled prescription order of another customer who had the same last name. A copy of the court ruling affirming that judgment is attached to the concurrently filed Declaration of Stephen Garrett.

The issue of pharmacies distributing incorrect prescription orders to customers has been around for a long period of time. For example, a scene in the classic 1946 film "It's A Wonderful Life" focuses on the main character, George Bailey, correcting a mistake of the pharmacist that would have resulted in a customer receiving the wrong prescription order.

Yet, despite this long felt need to correct this problem and the prior attempts of others to correct it, many customers are still inadvertently being given the wrong prescription orders.

The present invention successfully corrects this problem by performing at least one, and preferably all, of the following steps:

- a. automatically tracking a filled prescription order throughout the pharmacy;
- b. automatically tracking a customer's filled prescription within a storage area;
- c. providing a storage area with individual storage areas, with each one having a unique identifier;
- d. tracking a filled prescription order to a specific, worker elected, individual storage area (claim 44), wherein the visual identifier for that storage area is not related to information contained within the customer information;
- e. automatically verifying that a particular prescription order removed from a particular individual storage area is the correct prescription of the customer seeking to pick-up his or her prescription order.

Since there has been a long-felt need for the present invention, and that need was recognized and persistent, but since others did not solve that need prior to the

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present invention, applicants maintain that the references of record cannot be interpreted so as to render the present invention obvious.

2. Commercial Success

Applicants respectfully traverse the examiner's 35 USC § 103 rejections of the pending claims on the grounds of applicant's commercial success derived from the claimed invention under MPEP §716.03. Evidence in support of applicants' commercial success is provided in the attached declaration of Stephen Garrett dated September 30, 2004.

As Mr. Garrett's declaration states, assignee of record, GSL Solutions, Inc. was a start-up organization with little funding and no customers entering a field dominated by a handful of well-funded, large manufacturers. At the time GSL Solutions, Inc. introduced its automated tracking and will-call storage and retrieval system, no pharmacy equipment manufacturer offered the benefits of GSL Solutions, Inc.'s system.

Despite the short time since GSL Solutions, Inc. has been in business, its limited size and resources, and numerous obstacles resulting from having an industry dominated by a hand-full of well-financed and well-connected manufacturers, GSL Solutions, Inc., and its one product -- the claimed invention, have had numerous sales and have grown to become a viable and competitive pharmacy equipment manufacturer.

In the present case, GSL Solutions, Inc.'s success cannot be attributed to its already existing status in the industry or to its superior sales forces or advertising. It has become successful in such a short time despite its initial weak position in the industry.

A particular high point in GSL Solutions, Inc.'s success to date is the fact that a commercial embodiment of the structure disclosed in U.S. Pat. No. 6,464,142 to Denenberg et al. has proven problematic for its customer, who has elected to replace it with GSL Solutions, Inc.'s system. (See Declaration of Stephen Garrett, paragraphs 2, 9 & 10.)

When pharmacies are facing multi-million dollar lawsuits over improperly dispensing filled prescription orders from an overstuffed and error-prone will call storage system, and the dominant pharmacy equipment manufacturers are more interested in selling expensive, complex machinery than solving this problem for its

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customers, GSL Solutions, Inc.'s commercial success underscore the value of its system and offers further evidence of the non-obviousness of the present invention.

3. Evidence of Copying

"Another form of secondary evidence which may be presented by applicants during prosecution of an application . . . is evidence that the competitors in the marketplace are copying the invention instead of using the prior art." MPEP § 716.06.

"Copying is an indicium of nonobviousness, and is to be given proper weight."

Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679, 7 USPQ2d 1315, 1319 (Fed. Cir. 1988).

As noted in the declaration of Stephen Garrett, at least one large, well-funded pharmacy equipment manufacturer was specifically shown the GSL Solutions, Inc. system in operation, and was specifically asked by a customer to copy it. Shortly thereafter, that customer purchased the large, well-funded, pharmacy equipment manufacturers' copied system. (See Declaration of Stephen Garrett, paragraphs 12-14.)

This copying further underscores the non-obviousness of the present invention.

In light of the fact that there had been an unresolved long felt need for GSL Solutions, Inc.'s system, GSL Solutions, Inc. is enjoying commercial success for its system, and its competitors have attempted to copy its system, applicants maintain that this evidence supports a finding that the present invention cannot be rendered obvious by any combination of the references.

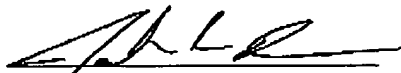
CONCLUSION

In view of the foregoing, applicants submit that all of the currently pending claims are in condition for allowance, and respectfully request that the case be passed to issuance. If the Examiner has any questions, he is invited to contact applicants' attorney at the below-listed telephone number.

Respectfully submitted,

July 21, 2006

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